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| 10/827,157 | 04/19/2004 | Susan M. Britton | P00949-US-01 (14319.0022) | 2706 |
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| ICE MILLER LLP | | | MERCHANT, SHAHID R | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|--------------------------------|-----------------|-------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/827,157 | BRITTON, SUSAN M. |
| Examiner Shahid R. Merchant | Examiner | Art Unit |
| | | 3692 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 September 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 26 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-10, 12-25 and 27-35 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Status of the Claims

1. This action is in response to the amendment filed on September 17, 2007. Claims 1-35 are pending. Claims 11 and 26 have been cancelled. Claims 1, 3, 11, 27 and 34 have been amended.

Response to Arguments

2. Examiner notes that claims 11 and 26 have been cancelled. However, Applicant states on page 10 that claim 26 has been amended to change the reference to "code(s)" to "trade identifier(s)". Examiner believes this is a typo and that Applicant intended to state claim 27 has been amended.

3. Applicant's arguments, see page 10, filed September 17, 2007, with respect to claims 11, 26 and 27 (35 USC 112 1st paragraph) have been fully considered and are persuasive. The rejection of claims 11, 26 and 27 (35 USC 112 1st paragraph) has been withdrawn.

4. Applicant's arguments with respect to claims 1, 2, 5-10, 12, 17, 18, 22-25, 28-31 and 33-35 have been considered but are moot in view of the new ground(s) of rejection.

5. Applicant's arguments with respect to claims 3, 4, 20 and 21 have been considered but are moot in view of the new ground(s) of rejection.

6. Applicant's arguments filed September 17, 2007 in regards to claims 13-16, 19 and 32 have been fully considered but they are not persuasive. Applicant contends that TD Canada Trust does not qualify as prior art under 35 U.S.C. § 102(b). Examiner

agrees that TD Canada Trust does not qualify as prior art under 35 U.S.C. § 102(b).

However, TD Canada Trust **does qualify** as 35 U.S.C. § 103(a) art. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of section 102 as referenced above:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (c) he has abandoned the invention.
- (d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- (f) he did not himself invent the subject matter sought to be patented.
- (g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

TD Canada Trust falls under 102(a). Therefore, it is qualified prior art under 103(a).

Reference U has a publication date of June 14, 2001 and Reference X has a publication date of August 4, 2001 that would qualify them under 102(b).

References V and W have publication dates of October 2, 2003 that would qualify them under 102(a).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 5-10, 12, 17, 18, 22-25, 28-31 and 33-35 rejected under 35 U.S.C. 103(a) as being unpatentable over Burakoff et al., US Patent Application Publication 2002/0065896 (see PTO-892, Ref. A) in view of Burakoff et al., U.S. Patent No. 6,122,635 (see PTO-892, Ref. C) [Hereinafter Burakoff '635].

9. Claims 1, 2, 5-10, 12, 17, 18, 22-25, 28-31 and 33-35 rejected under 35 U.S.C. 102(b) as being anticipated by Burakoff et al., US Patent Application Publication 2002/0065896 (see PTO-892, Ref. A).

10. As per claim 1, Burakoff teaches a system comprising:
a network (see paragraphs 28 and 41);

an electronic document source for storage of at least one investor document, the electronic document source operatively connected to the network (see paragraphs 29, 47 and 49);

a history source operatively connected to the network, the history source comprising history data representative of at least one past transaction for at least one investor (see paragraphs 29, 43 and 49);

a processor operatively connected to the network, the processor programmed to receive current investment data for an investor (see paragraphs 28-29), identify from the history source past transaction(s), if any, for the investor (see paragraph 29), identify document(s) from the at least one investor document applicable to the current investment data received (see paragraphs 29-30), determine required investment information for the investor from the identified document(s) applicable to the transaction and based on the past transaction(s) identified (see paragraphs 30 and 43), and retrieve the required investment information from the at least one investor document stored on the electronic document source (see paragraphs 30 and 44).

Burakoff does not explicitly teach investor documents comprising a plurality of parts with each of the plurality of parts defined with a trade identifier and determining required investment information for the investor by the use of trade identifiers.

Burakoff '635 teaches investor documents comprising a plurality of parts with each of the plurality of parts defined with a trade identifier and determining required investment information for the investor by the use of trade identifiers (see column 4, lines 11-24, column 7, lines 10-50 and column 10, lines 29-45).

Therefore, it would be *prima facie* obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Burakoff and Burakoff '635 to define parts of investor documents with trade identifiers and determine required investment information by using the trade identifiers because it would be quick and efficient for a user to type in a CUSIP or stock ticker symbol to get information rather than the complete name of a stock or mutual fund as taught by Burakoff '635 (see column 2, lines 4-26).

11. As per claim 2, Burakoff and Burakoff '635 teach the system of claim 1 as described above. Burakoff further teaches wherein the processor is further programmed to consolidate the retrieved investment information into a single package per investor (see paragraph 52).

12. As per claim 5, Burakoff teaches the system of claim 2 as described above. Burakoff further teaches wherein the consolidation performed by the processor produces the single package in a desired electronic format (see paragraph 52).

13. As per claim 6, Burakoff teaches the system of claim 2 as described above. Burakoff further teaches wherein the consolidation performed by the processor produces the single package in a desired format for printing a hard copy thereof (see paragraphs 52, 55 and 57).

14. As per claim 7, Burakoff teaches the system of claim 6 as described above. Burakoff further teaches wherein the processor is further programmed to receive a request for production of the single package, and wherein the production of the single package is performed in response to the request for production (see paragraph 66).

15. As per claim 8, Burakoff teaches the system of claim 7 as described above. Burakoff further teaches wherein the request for production comprises receipt by the processor of the current investment data (see paragraph 53).
16. As per claim 9, Burakoff teaches the system of claim 7 as described above. Burakoff further teaches wherein the production of the single package occurs within a prescribed time period (see paragraph 53).
17. As per claim 10, Burakoff teaches the system of claim 9 as described above. Burakoff further teaches wherein the prescribed time period is established by a legal rule applicable to the current investment data (see paragraph 53).
18. As per claim 12, Burakoff and Burakoff '635 teach the system of claim 1 as described above. Burakoff further teaches wherein at least one of the at least one investor documents comprises a compliance document (see paragraph 53).
19. As per claim 17, Burakoff and Burakoff '635 teach the system of claim 1 as described above. Burakoff further teaches wherein at least one of the at least one investor documents comprises a financial report (see paragraph 53).
20. As per claim 18, Burakoff teaches the system of claim 17 as described above. Burakoff further teaches wherein the financial report consists of one of the group of annual report, semi-annual report, quarterly report, or monthly report (see paragraph 53).
21. As per claim 22, Burakoff and Burakoff '635 teach the system of claim 1 as described above. Burakoff further teaches wherein the history data stored on the history source comprises past securities transactions data (see paragraph 67).

22. As per claim 23, Burakoff and Burakoff '635 teach the system of claim 1 as described above. Burakoff further teaches wherein the history data stored on the history source comprises past investor account holding data (see paragraph 67).
23. As per claim 24, Burakoff and Burakoff '635 teach the system of claim 1 as described above. Burakoff further teaches wherein the history data stored on the history source comprises past documents sent identification data (see paragraph 68).
24. As per claim 25, Burakoff and Burakoff '635 teach the system of claim 1 as described above. Burakoff further teaches wherein the current investment data comprises an identifier for the investor and wherein the history data comprises an identifier for the at least one investor, such that the processor uses the identifier for the investor from the current investment data and the identifier for the at least one investor of the history data to identify past transaction(s), if any (see paragraph 68).
25. As per claim 28, Burakoff and Burakoff '635 teach the system of claim 1 as described above. Burakoff further teaches wherein the required investment information comprises a portion of one of the at least one investor documents (see paragraph 53).
26. As per claim 29, Burakoff and Burakoff '635 teach the system of claim 1 as described above. Burakoff further teaches wherein the determination of the required information performed by the processor is based on at least one legal rule (see paragraph 53).
27. As per claim 30, Burakoff and Burakoff '635 teach the system of claim 1 as described above. Burakoff further teaches wherein the determination of the required

information performed by the processor is based on at least one business rule (see paragraph 54).

28. As per claim 31, Burakoff and Burakoff '635 teach the system of claim 1 as described above. Burakoff further teaches wherein at least one of the identified document(s) comprises a plurality of parts, and wherein the required investor information determined by the processor comprises at least one of the plurality of parts (see paragraph 53).

29. As per claim 33, Burakoff and Burakoff '635 teach the system of claim 1 as described above. Burakoff further teaches wherein the processor is further programmed to convert the retrieved required investment information into a format suitable for printing (see paragraphs 55-57).

30. Claim 34 recites similar limitations to claim 1 and thus rejected using the same art and rationale in the rejection of claim 1 as set forth above.

31. Claim 35 recites similar limitations to claim 2 and thus rejected using the same art and rationale in the rejection of claim 2 as set forth above.

32. Claims 3, 4, 20 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Burakoff et al., US Patent Application Publication 2002/0065896 (see PTO-892, Ref. A) in view of Burakoff et al., U.S. Patent No. 6,122,635 (see PTO-892, Ref. C) [Hereinafter Burakoff '635] and further in view of Bosarge et al., US Patent Application Publication 2003/0191689 (see PTO-892, Ref. B).

33. As per claims 3 and 4, Burakoff teaches the system of claim 2. Burakoff does not explicitly teach wherein the processor is further programmed to retrieve a secondary document, and wherein the consolidation performed by the processor includes consolidation of the secondary document together with the retrieved investment information and wherein the secondary document comprises at least one of the group consisting of a cover page, table of contents, back cover, artwork, advertisement, trade confirmation, or disclaimers.

Bosarge teaches wherein the processor is further programmed to compose a secondary document, and wherein the consolidation performed by the processor includes consolidation of the secondary document together with the retrieved investment information and wherein the secondary document comprises at least one of the group consisting of a cover page, table of contents, back cover, artwork, advertisement, trade confirmation, or disclaimers (see paragraphs 5-6).

Therefore, it would be *prima facie* obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Burakoff and Bosarge to consolidate a secondary document with the retrieved investment information because it gives a third party content provider an ability to entice a recipient of an email to view or click the third-party content as taught by Bosarge (see paragraphs 5-6).

34. As per claims 20 and 21, Burakoff and Burakoff '635 teach the system of claim 1. Burakoff does not explicitly teach wherein at least one of the at least one investor documents comprises a secondary document and further comprising: a secondary document source operatively connected to the network, the secondary document

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source comprising at least one secondary document, and wherein the processor is further programmed to determine required secondary documents applicable to the transaction and retrieve the required secondary documents from the secondary document source.

Bosarge teaches wherein at least one of the at least one investor documents comprises a secondary document and further comprising: a secondary document source operatively connected to the network, the secondary document source comprising at least one secondary document, and wherein the processor is further programmed to determine required secondary documents applicable to the transaction and retrieve the required secondary documents from the secondary document source. (see paragraphs 5-6).

Therefore, it would be *prima facie* obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Burakoff and Bosarge to compose a secondary document applicable to a transaction because it gives a user an ability to customize the secondary document based on individual, group or company as taught by Bosarge (see paragraphs 5-6).

35. Claims 13-16, 19 and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Burakoff et al., US Patent Application Publication 2002/0065896 (see PTO-892, Ref. A) in view of Burakoff et al., U.S. Patent No. 6,122,635 (see PTO-892, Ref. C) [Hereinafter Burakoff '635] and further in view of website www.tdcanadatrust.com (hereinafter TD Canada Trust) as evidenced by TD Mutual Funds Download Centre

(see PTO-892, Ref. U), TD Mutual Funds Fund Profiles (see PTO-892, Ref. V), TD Mutual Funds Simplified Prospectus (see PTO-892, Ref. W) and TD Mutual Funds Disclosure (see PTO-892, Ref. X).

36. As per claims 13-16 and 32, Burakoff teaches the system of claim 12 as described above. Burakoff does not explicitly teach wherein the compliance document comprises a simplified prospectus, wherein the simplified prospectus comprises a mutual fund simplified prospectus including a Part A and a plurality of Part Bs, wherein the identified document(s) comprise one of the plurality of Part Bs, wherein the required investment information further comprises one of the Part A or a Part A Note and at least one of the plurality of parts of the identified document(s) is (are) retrieved by the processor when retrieving the required investment information.

TD Canada Trust teaches wherein the compliance document comprises a simplified prospectus (see Ref. W), wherein the simplified prospectus comprises a mutual fund simplified prospectus including a Part A and a plurality of Part Bs (see Ref. U, V and W), wherein the identified document(s) comprise one of the plurality of Part Bs and wherein the required investment information further comprises one of the Part A or a Part A Note (see Ref. U, V and W) and at least one of the plurality of parts of the identified document(s) is (are) retrieved by the processor when retrieving the required investment information (see Ref. U).

Therefore, it would be *prima facie* obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Burakoff and TD Canada Trust to provide a simplified prospectus comprising of Part A and B because it provides a

potential investor with information required to make an investment decision (see Ref. V and W).

37. As per claim 19, Burakoff and Burakoff '635 teach the system of claim 1 as described above. Burakoff does not explicitly teach wherein at least one of the at least one investor documents comprises a new account disclosure document.

TD Canada Trust teaches wherein at least one of the at least one investor documents comprises a new account disclosure document (see Ref. X).

Therefore, it would be *prima facie* obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Burakoff and TD Canada Trust to provide a Disclosure because it provides a potential investor with information required to make an investment decision (see Ref. X).

Conclusion

38. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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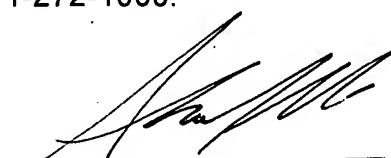
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid R. Merchant whose telephone number is 571-270-1360. The examiner can normally be reached on First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz P. Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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